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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/223,773	12/31/1998	GREGORY S. LINDHORST	3797.09761	3335

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EXAMINER

QUELER, ADAM M

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 07/08/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/223,773

Applicant(s)

LINDHORST ET AL.

Examiner

Adam M Queler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: Amendment E filed on 4/12/2003.
2. Claims 1-20 are pending in the case. Claims 1, 8, and 17 are independent claims. Claims 17-20 have been withdrawn.
3. The rejections of claims 1-16 under §§ 102-103 are withdrawn in view of Applicant's amendment.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 1-16** remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The converter reconverts the serial execution code into a second event-driven program is not disclosed in the specification. In the interview on 4/2/2002, Applicant's Attorney discussed an example in the specification that allegedly covered the claimed subject matter, on page 24, ll. 17-22. It is the position of the Office that both codes still represent event-driven code. Both code portions are dependent on an event being fired, "onclick." Applicant discloses a similar example on page 26, ll. 4-8. In this case as well while the code has changed shifted from an event-driven paradigm to that of a HTML attribute, the specification would not enable a person of ordinary skill in the art to convert event-driven programs into serial execution code, and in addition does not teach one how to reconvert the code back.

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The dependent claims are rejected for fully incorporating the deficiencies of the base claim.

Regarding dependent claim 7, it is not clear how changing an object to code equivalent to the object, and then changing the code back to an object equivalent to the code would result in a different program.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. **Claims 1-16** remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Due to deficiencies in the disclosure it is not apparent how this claimed subject matter is possible. From the interviews and the amendments to claims, it appears that Applicant's recitation of "event-driven program" is intended to mean "object-oriented program." While event-driven programs are frequently object-oriented, and the example given in the specification is for an event-driven program (the event being a mouse click) that does not appear to be what the Applicant intended. Objects have methods and properties, which are exposed, which are not necessarily event driven. While the Office recognizes that the Applicant has the right to limit the claim to event-driven programs if desired, in light of conversion to serial-execution code (not even-driven), and back again, it appears this not what Applicant intended, especially in light of the fact that the Examiner is not aware of anything capable of reforming serial code to event-driven code. While the Office recognizes the right of the Applicant to be their own lexicographer, in this case Applicant has given terms meanings repugnant to their definitions. MPEP § 608.01(o) states, "No term may be given a meaning repugnant to the usual

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meaning of the term.” Therefore, for examining purposes only “event-driven” will be considered to mean “object-oriented.” As for serial-execution code, this also does not appear to Applicant’s intention, as the aforementioned “onclick” code is event-driven. For examining purposes only, the term will be taken to mean HTML, which is not the same thing as serial-execution code. Additionally, at claim 1, line 4, “first event-driven program coding a method or property,” appears to have a minor grammatical error. For examining purposes only, it will be broadly interpreted to mean a program code including a method or a property.

Regarding dependent claim 7, the claim language of “reconverting,” meaning “reverting to a previous state” does not make sense in light of claim 7 claiming that the two programs are different.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. **Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson et al (US005956736A, filed 9/27/1996), and further in view of Popp (US006651108B2, filed 8/14/1995).**

Regarding independent claim 1, Hanson teaches receiving input from a designer, comprising an object with properties (col. 4, ll. 26-39). Hanson teaches converting and outputting HTML that is a representation of the object (col. 4, ll. 43-45). Hanson does not teach reconverting HTML to objects. Popp teaches converting an HTML document into objects based on the

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HTML. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Popp with Hanson because the text form of HTML cannot be easily extended and specialized like objects can (Hanson, col. 4, ll. 19-20).

Regarding dependent claim 2, Hanson teaches client receiving HTML (serial execution code) from a server (col. 3, ll. 23-29). All programs (objects) on all web pages “operate between a client and a server” as they are transmitted. Hanson teaches an editor that treats all objects the same; therefore, it is shown as operating as if they are on a single machine (col. 4, ll. 26-39).

Regarding dependent claim 3, Hanson teaches receiving input from a designer, comprising an object with properties (col. 4, ll. 26-39).

Regarding dependent claim 4, Hanson teaches adding scripts to a script library for later placement (col. 13, ll. 20-50).

Regarding dependent claim 5, Hanson discloses controls for generating objects (col. 7, ll. 25-28).

Regarding dependent claim 6, Hanson teaches receiving input from a designer, comprising an object with properties (col. 4, ll. 26-39). Hanson teaches converting and outputting HTML that is a representation of the object (col. 4, ll. 43-45). Hanson does not teach reconvert HTML to objects. Popp teaches converting an HTML document into objects based on the HTML. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Popp with Hanson because the text form of HTML cannot be easily extended and specialized like objects can (Hanson, col. 4, ll. 19-20).

As this conversion changes an object to code equivalent to the object, and then changes the code back to an object equivalent to the code, inherently the objects are the same.

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Regarding dependent claim 7, Neither Hanson or Popp explicitly discloses the first and second program being the same. However, it would have been obvious to one of ordinary skill in the art at the time of the invention that slight difference would appear in the conversion, rendering them different programs.

Regarding dependent claim 15, Hanson teaches that markup language is HTML (col. 4, ll. 43-45).

Regarding Claims 8-14 and 16, the methods encompassing the same limitations as claims 1-7 and 15 are rejected under the same rationale.

Response to Arguments

10. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Regarding Applicant's remarks on § 112 rejections:

The Office would like to thank Applicant for their efforts in interviews and the current amendment, to more clearly convey the claims as to enable a proper search for the intended invention. While the Office believes that the intended invention is now understood, the amendment still does not place the claims in a form that complies with 35 U.S.C 112, as explained in the rejections above.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (703) 308-5213. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ



STEPHEN S. HONG
PRIMARY EXAMINER